

In re: Appln No. 09/716,146

Atty Docket: 6006-018

REMARKS

Presently, claims 16, 20 and 26-28 remain pending, all of which the Patent Office has rejected as anticipated over Brown et al. (US Pat. No. 6,071,305) or Ragheb et al. (US Pat. No. 6,096,070).

Applicants submit to the Patent Office that the rejection over Brown et al. is improper because it failed to meet the burden of establishing a *prima facie* case of anticipation under section 102(e). As stated in MPEP §2131, anticipation requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. V. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The Patent Office has failed to establish that Brown et al. describes all elements of the claimed invention. In support, the Patent Office even goes so far as to adapt the disclosure to form the basis of its anticipation rejection. In the last paragraph of page 2, the Patent Office explains that, "If the cross-section of the structural elements is square, . . ." (emphasis added) that Brown et al. would describe the layered structure of the present invention. Further, in the last paragraph of page 3, the Patent Office continuously uses the phrase "imagining" to describe the layers in fig. 6 or 8, e.g., "imagining Brown's disclosed square cross-section. . ." In sum, these explanations emphasize that Brown et al. fails to provide the required description to form a *prima facie* case of anticipation. Accordingly, the Applicants respectfully request that the rejection be withdrawn as inappropriate.

I. Rejection of pending claims 16, 20, and 26-28 over Brown et al. (US Pat. No. 6,071,305) Should be Withdrawn

The rejection over Brown et al. should be withdrawn because Brown et al. fails to disclose all elements of the claimed invention. Brown et al. simply fails to disclose a void layer between two layers, as argued in Applicant's last response, and, further, fails to disclose a first region having a base layer and a second region having a second layer covering the base layer, forming a void layer. Furthermore, the basis for forming this rejection is lacking because there is the Patent Office has failed to point out any description in Brown et al. that discusses a first region and second region of a structural member as the present claims describe, and therefore, the Patent Office has failed to establish its *prima facie* case.

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Brown et al. is limited to describing a tubular structural member that is modified by laser etching to form grooves, see col. 12, ln 22-25, or slits, see col. 6, ln. 40-45, instead of the claimed layer structure of the claimed invention. The methods of manufacture described in Brown et al. do not include a method that would allow for the formation of a structure that comprises a first region having a first layer and a second region having a first and second layer with a void layer in-between. See Col. 3, ln. 46-55 in the Summary of the Invention section and col. 12, ln. 1-13 in the Description of the Preferred Embodiments section (discloses only the post-fabrication modification of a elongated tubular member to form recessed regions for receiving an active agent). Additionally, the figures, contrary to the Patent Office, fail to show a first region with a base layer and a second region having a second layer covering the base layer to form a void layer. Furthermore, there is nothing in Brown et al. to suggest that the structural elements can be modified into a square cross-section as so readily modified by the Patent Office.

Additionally, Brown does not disclose "a void space comprising a plurality of independent internal cavities along the length of the structural elements" as stated by the Patent Office on page 4 of the Office Action. In fact, the passage cited by the Patent Office (col. 5, lines 52-55) only states that "the interior may be **other configurations** [other than concave groove] and need not extend the entire length of the elongated or tubular member 12." This suggests configurations that are not a concave groove and that, unlike the groove in the figures, that the other configurations can be shorter than the length of the tubular member. It is difficult to determine how this passage describes, let alone suggests, to one of ordinary skill in the art "a void space comprising a plurality of independent internal cavities." Based on the proper reading of Brown, a description of the limitation on a plurality of independent internal cavities is lacking.

Accordingly, should the Patent Office continue to pursue this rejection based on the rationale provided in the current Office Action, the rejection under Brown et al. should be withdrawn because Brown et al. fails to describe all elements of the claimed invention.

II. Rejection of pending claims 16 and 26-28 over Ragheb et al. (US Pat. No. 6,096,070) Should be Withdrawn

In light of the current amendments, the rejection over Ragheb et al. is moot because Ragheb et al. does not disclose a second layer fabricated of a metal. Instead, Ragheb et al. describes that a second layer, the porous layer, is fabricated of a polymer, "preferably polyamide,

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paylene or a parylene derivative." Col. 10, ln. 46-48. In addition, with regard to claim 26, Ragheb et al. only discloses a base layer formed of a number of metals and not the group of metals provided for in the claimed invention.

Accordingly, the rejection under Ragheb et al. should be withdrawn.

CONCLUSION

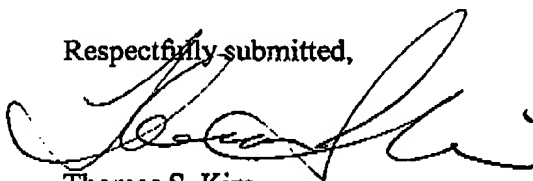
Based upon the foregoing amendments, pending claims 16, 20 and 26-28 are suitable for allowance and Applicants respectfully request allowance of these claims.

This Amendment and Response to Office Action is being filed timely as a proper Extension of Time is provided, with the appropriate fees. However, the Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Rosenbaum & Associates, P.C. deposit account No. 18-2000.

Applicant draws the Examiner's attention to the Notice of Change of Entity Status and Notice of Change of Address of Attorney of Record being filed concurrently herewith.

The Examiner is encouraged to telephone the undersigned should there be any outstanding issues which may be resolved telephonically.

Respectfully submitted,



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